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EXAMINER

WONG, LESLIE

ART UNIT PAPER NUMBER

2167

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/872,938

**Applicant(s)**

LYNCH ET AL.

**Examiner**

Leslie Wong

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Request for Reconsideration*

1. Receipt of Applicant's Request for Reconsideration, filed 15 July 2004, is acknowledged.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 7-9, 13-17, 19-30, 35-36, are 39-41 are rejected under 35 U.S.C. 102(e) as being anticipated by **Wheeler et al.** ("Wheeler") (U.S. Patent 6,618,727 B1).

Regarding claims 1, 13, 21, 24, and 27, **Wheeler** teaches method, apparatus, and article or manufacture, comprising:

- a). generating a list of one or more related documents ranked (col. 2, lines 11-13) based upon relevance to a first representation of content associated with a first field of a reference extensible markup language document, the first representation including a set of terms and one or more weighted values associated with each term in the set of terms (col. 2, lines 36-47; col. 7, lines 56-65; col. 20, lines 36-47 and Fig. 25);

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b). generating a link to each of the one or more related documents (col. 2, lines 21-26).

Regarding claims 2 and 3, **Wheeler** further teaches wherein the first field in the reference extensible markup language document is specified at the time a query is generated (col. 2, lines 42-44).

Regarding claims 4 and 14, **Wheeler** further teaches wherein the reference extensible markup language document is selected from a group of documents in a database (i.e. source database) (col. 2, lines 39-42).

Regarding claim 5, **Wheeler** further teaches wherein submitting the reference extensible markup language document to an engine for analysis (col. 9, lines 52-65).

Regarding claim 7, **Wheeler** further teaches wherein the second field of the related document contains semantically similar content to the content associated with the first field of the reference extensible markup language document (col. 11, lines 10-18).

Regarding claims 8, 20, 28, and 41, **Wheeler** further teaches executing a query on the reference extensible markup language document to generate the list and the link without a user having to request the query (col. 19, lines 60-64 and Fig. 24).

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Regarding claim 9, **Wheeler** further teaches wherein the list further includes references to relevant fields within each related document (Fig. 21G).

Regarding claim 15, **Wheeler** further teaches a database containing a plurality of representations, each representation being associated with content in a particular field in an extensible markup language document (Fig. 24 and col. 19, lines 60-65).

Regarding claim 16, **Wheeler** further teaches wherein the engine adjusts the one or more weighted values for each particular term in the set of terms by a comparison to a historical weighted value associated with each particular term in the set of terms (col. 12, line 60- col. 13, line 8).

Regarding claim 17, **Wheeler** further teaches a converter to convert a non-extensible markup language document into an extensible markup language format (col. 9, lines 56-65).

Regarding claim 19, **Wheeler** further teaches wherein the engine has a module to compare the first representation to a plurality of representations in a database in order to identify documents that are most similar to the first representation (Figs. 24 and 25; col. 19, lines 60-65; col. 20, lines 36-47).

Regarding claims 22 and 25, **Wheeler** further teaches wherein the reference extensible markup language document has a first extensible markup language schema, and a first related extensible markup language document has a second extensible markup language schema (col. 9, lines 56-65).

Regarding claims 23 and 26, **Wheeler** further teaches the steps of:

- a). identifying a first representation of content associated with the reference extensible markup language document, the first representation including a first set of terms and one or more weighted values associated with each term in the first set of terms (i.e., suspect's height weight 50%) (col. 11, lines 55-63);
- b). identifying a second representation of content associated with a second field in a first related extensible markup language document, the second representation including a second set of terms and a second weighted value associated with each term in the second set of terms (i.e., suspect's weight and hair color weight 25%)(col. 11, lines 55-63).

Regarding claims 29, 30, 35, 36, 39, and 40, **Wheeler** further teaches a method, comprising:

- a). executing a query on content from a active desktop window without a user having to request the query (col. 19, lines 60-64 and Fig. 24).
- b). generating a ranked list of documents related to the content based on the content in the active desktop window (col. 2, lines 11-13);

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- c). generating links to the documents (col. 2, lines 21-26).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Wheeler et al.** ("Wheeler") (U.S. Patent 6,618,727 B1) as applied to claims 1-5, 7-9, 13-17, 19-30, 35-36 are 39-41 above and in view of **Blumenthal** (U.S. Patent 6,026,409).

Regarding claim 6, **Wheeler** does not explicitly teach wherein the link is a hypertext link.

**Blumenthal**, however, teaches wherein the link is a hypertext link (col. 2, lines 1-5).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Blumenthal's** teaching would have allowed **Wheeler's** to easily and conveniently access to desired documents.

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6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Wheeler et al.** ("Wheeler") (U.S. Patent 6,618,727 B1) as applied to claims 1-5, 7-9, 13-17, 19-30, 35-36, are 39-41 above and in view of **Schuetze** (U.S. Patent 5,675,819).

Regarding claim 10, **Wheeler** does not explicitly teach wherein the set of terms includes singular terms and higher order terms.

**Schuetze**, however, teaches wherein the set of terms includes singular terms and higher order terms (col. 13, lines 5-21).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Schuetze's** teaching would have allowed **Wheeler's** to assign the ranking for relevant terms more effectively.

7. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Wheeler et al.** ("Wheeler") (U.S. Patent 6,618,727 B1) as applied to claims 1-5, 7-9, 13-17, 19-30, 35-36, are 39-41 above and in view of **Kirsch et al.** ("**Kirsch**") (U.S. Patent 5,983,216).

Regarding claim 11, **Wheeler** does not explicitly wherein the set of terms includes singular terms and noun phrases.

**Kirsch**, however, teaches wherein the set of terms includes singular terms and noun phrases (claim 2, a).



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It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Kirsch's** teaching would have allowed **Wheeler's** to apply the apply the selected single terms and noun phrases to the meta-index descriptive of the document collections to determine the cumulative rankings for the documents.

Regarding claim 12, **Wheeler** does not explicitly wherein the set of terms includes higher order terms and proper names.

**Kirsch**, however, teaches wherein the set of terms includes higher order terms and proper names (claim 2, limitation d).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Kirsch's** teaching would have allowed **Wheeler's** to apply the apply the selected single terms and noun phrases to the meta-index descriptive of the document collections to determine the cumulative rankings for the documents.

8. Claims 18, 33, 34, 38, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Wheeler et al.** ("Wheeler") (U.S. Patent 6,618,727 B1) as applied to claims 1-5, 7-9, 13-17, 19-30, are 39-41 above and in view of **Agrawal et al.** ("**Agrawal**") (U.S. Patent 5,675,819).

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Regarding claims 18, 33, 38, and 43, **Wheeler** does not explicitly wherein the non-extensible markup language document is content associated with an e-mail, content associated with a web page, or content associated with a software application.

**Agrawal**, however, teaches wherein the non-extensible markup language document is content associated with an e-mail, content associated with a web page, or content associated with a software application (col. 1, lines 13-25).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Agrawal's** teaching involves organizing repositories of documents such as emails and web pages in folders, and the folders can be arranged in a tree-like hierarchy structure would have allowed **Wheeler's** to process variety types of documents in order to provide a more flexible system for user to manage and organize documents in an easy and effective manner.

Regarding claim 34, **Wheeler** does not clearly teach wherein the active desktop window is running an e-mail application.

**Agrawal**, however, teaches wherein the active desktop window is running an e-mail application (col. 4, lines 14-22).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Agrawal's** teaching would have allowed **Wheeler's** to have a means to collect and process variety types of unstructured or semi-structured documents.

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9. Claims 31, 32, 37, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Wheeler et al.** ("Wheeler") (U.S. Patent 6,618,727 B1) as applied to claims 1-5, 7-9, 13-17, 19-30, are 39-41 above and in view of **Jeffrey** (US 20030084040A1).

Regarding claims 31, 32, 37, and 42, **Wheeler** does not clearly teach wherein the probabilistic algorithm uses a Bayesian model.

**Jeffrey**, however, teaches wherein the probabilistic algorithm uses a Bayesian model (paragraph 19).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Jeffrey's** teaching involves document retrieval for wide ranges of subject matter, such as exhibited by the Internet, general libraries, and other broad-coverage information collections and comparing documents includes segmenting a judgment matrix into a plurality of information sub-matrices where each sub-matrix has a plurality of classifications and a plurality of terms relevant to each classification would have allowed **Wheeler's** to effectively calculate the probability of the relevant terms for the target documents in order to produce more accurate results.

### ***Response to Argument***

10. Applicants' arguments filed 15 July 2004 have been fully considered but they are not persuasive.

Applicants argue that Wheeler does not disclose the generation of a list of one or more related documents ranked upon relevance to a first representation of content. In contrast, Wheeler merely discloses a parent-child hierarchy, in which a child category is linked with its corresponding parent category through an entry in a data structure. In response to the preceding arguments, Examiner respectfully submits that Wheeler teaches similarity search system and method that allows for efficiently searching very large source databases for similarity search criteria specified in a query (col. 1, lines 7-10). Wheeler displays the results of a document comparison similarity search which shows the side by side display of the document comparison search result for two documents. The document labeled anchor 340 is the first document in a hierarchical language that is annotated with a scoring method, weighting and parent scoring algorithm. The score 341 represents the similarity search results as specified by the scoring method the objects of the first and second document (col. 20, lines 35-47).

Applicants argue that Wheeler does not disclose generating a list of related documents ranked based upon their semantic similarity to content in the first field in the reference extensible markup language document as claimed in independent claim 24. In response to the preceding arguments, Examiner respectfully submits that Wheeler teaches the above limitation as displaying the results of a document comparison similarity search which shows the side by side display of the document comparison search result for two documents. The document labeled anchor 340 is the first document in a hierarchical language (the hierarchical language may be XML or SGML

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(col. 2, lines 20-42)) that is annotated with a scoring method, weighting and parent scoring algorithm. The score 341 represents the similarity search results as specified by the scoring method the objects of the first and second document (col. 20, lines 35-47).

Applicants argue that Wheeler does not disclose the first representation including a set of terms and one or more weighted values associated with each term in the set of terms as claimed. In response to the preceding arguments, Examiner respectfully submits that Wheeler teaches the above limitation as the weighting among attributes 73 determines the relative weight to be given to each parent/child object in a search where there are multiple children within a parent object. For example, a parent category may contain as child categories or attributes the suspect's height, weight and hair color. The suspect's height will be given the importance of 50% while weight and hair color will be given the importance of 25%. The weighting will then be used to influence the combined score for the suspect individual (col. 11, lines 53-67).

Applicants argue that Wheeler does not disclose executing a query on the content from an active desktop window. In response to the preceding arguments, Examiner respectfully submits that Wheeler teaches the above limitation as FIG. 25 shows an example of a graphical user interface (i.e., active desktop window) displaying the results of a document comparison similarity search. It shows the side by side display of the document comparison search result for two documents. The document

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labeled anchor 340 is the first document in a hierarchical language that is annotated with a scoring method or algorithm (measure), weighting and parent scoring algorithm, the annotated first document becoming a query which is used to search a second document. The score 341 represents the similarity search results as specified by the scoring method for between the objects of the first and second document (col. 20, lines 35-47). Examiner interprets "active desktop window" in accordance with the meaning given by the Microsoft Press Computer Dictionary, Third Edition: "the window containing the display or document that will be affected by current cursor movements, commands, and text entry". Accordingly, Wheeler's graphical user interface used to display the query results for similarity search is equivalent to Applicants' active window desktop.

Applicants argue that the combination of Wheeler and Blumenthal do not make claim 6 obvious under 35 U.S.C. 103(a) as Wheeler and Blumenthal also do not disclose the generation of a list of one or more related documents ranked based upon relevance to a first representation of content. Examiner respectfully submits that Wheeler teaches the above limitation as detecting and scoring similarities between documents in a source database and a search criteria (col. 2, lines 9-11). The system assigns a number for the score that represents how similar (i.e., relevance) and dissimilar the value is to the search criteria (col. 2, lines 30-34). Further, Wheeler displays the results of a document comparison similarity search which shows the side by side display of the document comparison search result for two documents. The

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document labeled anchor 340 is the first document in a hierarchical language that is annotated with a scoring method, weighting and parent scoring algorithm. The score 341 represents the similarity search results as specified by the scoring method the objects of the first and second document (col. 20, lines 35-47).

Applicants argue that the combination of Wheeler and Schuetze do not make claim 10 obvious under 35 U.S.C. 103(a). Wheeler and Schuetze do not disclose the generation of a list of one or more related documents ranked based upon relevance to a first representation of content. Further, the combination of Wheeler and Schuetze would disclose the use of a weighting system between two documents wherein the first document becomes a query that is used to search a second document. Examiner respectfully submits that Wheeler teaches the above limitation as a first hierarchical language may be annotated with a scoring method or algorithm, weighting and parent scoring algorithm, the annotated first document becoming a query which is used to search a second document (col. 19, lines 60-64). Additionally, Wheeler displays the results of a document comparison similarity search which shows the side by side display of the document comparison search result for two documents. The document labeled anchor 340 is the first document in a hierarchical language that is annotated with a scoring method, weighting and parent scoring algorithm. The score 341 represents the similarity search results as specified by the scoring method the objects of the first and second document (col. 20, lines 35-47).

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Applicants argue that the combination of Wheeler and Kirsch do not make claims 11-12 obvious under 35 U.S.C. 103(a). Wheeler and Kirsch do not disclose the generation of a list of one or more related documents ranked based upon relevance to a first representation of content. In response to the preceding arguments, Examiner respectfully submits that Wheeler teaches the above limitation as described on page 11, first paragraph of this Office Action.

Applicants argue that the combination of Wheeler and Agrawal do not make claims 18, 33, 34, 38, and 43 obvious under 35 U.S.C. 103(a). Wheeler and Agrawal do not disclose executing a query on content from an active desktop window without a user having to request the query. In response to the preceding arguments, Examiner respectfully submits that Wheeler teaches the above limitation as described on page 13, first paragraph of this Office Action.

Applicants argue that the combination of Wheeler and Jeffrey do not make claims 31, 32, 37, and 42 obvious under 35 U.S.C. 103(a). Wheeler and Jeffrey do not disclose executing a query on content from an active desktop window without a user having to request the query. In response to the preceding arguments, Examiner respectfully submits that Wheeler teaches the above limitation as described on page 13, first paragraph of this Office Action.



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Applicants argue that because Wheeler specifically teaches away from such a combination. It would be impermissible hindsight to combine Wheeler with Blumenthal based on applicants' own disclosure. In response to applicants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Further, Applicants are requested to explain ***specifically*** how the Wheeler reference teaches away from the Applicants' invention in order for the Examiner to address the arguments properly. Applicants are also reminded that in order to disqualify a reference based on a "teach away" reasoning, the reference has to *explicitly* suggest or disclose the so-called teach away steps – Applicants assertion can not be accepted if it is unsupported by a valid evidence. Based on the above, Examiner submits that Wheeler teaches the limitations as spelled out from the above paragraphs and does not teach away from the Applicants' invention as indicated by the Applicants.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (571) 272-4120. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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LW

January 3, 2005



Primary Examiner